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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,542	01/10/2002	Barbara L. Jones	452700	4149

27717 7590 06/30/2004

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EXAMINER

KIM, PAUL D

ART UNIT PAPER NUMBER

3729

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/030,542	JONES, BARBARA L.	
	Examiner	Art Unit	
	Paul D Kim	3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-44 is/are pending in the application.
- 4a) Of the above claim(s) 30-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-29 and 39-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/25/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is a response to the restriction requirement filed on 4/30/04.

Response to the Restriction Requirement

1. Applicant's election of Group I, claims 24-29 and 39-44, in the reply filed on 4/30/04 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 30-38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 4/30/04.

Information Disclosure Statement

3. The listing of references in the specification, EP 0 244 513 B1, is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.
4. The information disclosure statement filed 3/25/02 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information

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submitted for consideration by the Office. It has been placed in the application file, WO 93/04381, but the information referred to therein has not been considered.

Specification

5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: --A METHOD AND APPARATUS FOR MOUNTING AN ACOUSTIC TRANSDUCER--.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 24 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re. claim 24: The phrase "like emitter or detector at its respective" as recited in line 4 renders the claim vague and indefinite. It is unclear whether the mounted transducer can be replaced by the emitter or detector or not. It is also unclear as to what the phrase "its" is indicated. Clarification is required.

Re. claim 39: The phrase "like transducer at its respective" as recited in line 4 renders the claim vague and indefinite. It is unclear whether the mounted transducer

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can be replaced by the transducer or not. It is also unclear as to what the phrase "its" is indicated. Clarification is required.

The phrase "the transducer detector" as recited in line 8 lacks antecedent basis.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 24-26, 39, 40 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by von Recklinghausen (US PAT. 4,037,061).

As per claims 24, 25 and 39 and 40 von Recklinghausen teaches a process and an apparatus for mounting a acoustic transducer comprising steps of: providing a portion of the transducer (2) (equivalent with an emitter or detector) to become held between opposed portions of polymeric bushings (8,9) which are located between the transducer and a structural mounting member (17,14), the bushings each comprising location-defining structure (9) and an isolating structure (8) to inhibit the transmission of energy between the structural mounting member and the transducer as shown in Figs. 1 and 5; providing the location-defining structure and the isolating structure as a single unitary structure comprising a non-elastic polymeric plastics material (equivalent with a non-metallic plastic) to acoustically isolate the transducer from the acoustically-

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transmissive structural mounting member; and providing the bushings as including two main structural respectively providing the opposed portions of the bushings and adapted to (capable of) snap-fit together (equivalent with engaging and gripping the edges of the transducer as disclosed in col. 2, lines 56-60) on opposite sides of the transducer as shown in Figs. 1 and 5 (see also col. 3, lines 4-col. 4, line 11).

As per claims 26 and 44 the transducer (2) and the acoustically-transmissive structural mounting member (14,17) are formed part of a system capable of three-dimension coordinate determination, and provided a means (23) for mounting the transducer (2) (equivalent with an emitter or detector) within the system as shown in Figs. 2 and 3.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 27-29 and 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over von Recklinghausen.

von Recklinghausen teaches all of the limitations as set forth above. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the non-elastomeric material as recited in the claimed invention because Applicant has not disclosed that the non-elastomeric

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material as recited in the claimed invention provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with von Recklinghausen because the non-elastomeric material as recited in the claimed invention would perform equally well such as non-metallic plastic in von Recklinghausen. Therefore, it would have been an obvious matter of design choice to modify the non-elastomeric material of von Recklinghausen to obtain the invention as specified in claims 27-29 and 41-43.


Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul D Kim whose telephone number is 703-308-8356. The examiner can normally be reached on Tuesday-Friday between 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul D Kim
Examiner
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